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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,392	02/17/2004	Owen H. Decker	FA1139USNA	1619
23906 7590 03/09/2009 E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1122B 4417 LANCASTER PIKE WILMINGTON, DE 19805				
EXAMINER ZIMMER, MARC S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/09/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

### Office Action Summary

**Application No.**

10/780,392

**Applicant(s)**

DECKER ET AL.

**Examiner**

MARC S. ZIMMER

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 11/28/08.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokota et al., JP 58-34870 A.

Yokota discloses a powder composition comprising all of the materials disclosed in the abstract. In the first paragraph on page 2 of the document, the glass powder is described in terms of a diameter thus the powder is clearly made up of solid spheroids. Given that (i) Yokota is not forthcoming as to what types of borosilicate glass are advocated, (ii) only three forms (crystalline, semi- crystalline, amorphous) are known, the Examiner should have taken the position that both a powder composition with crystalline- and amorphous borosilicate glass particles would have been obvious.

Concerning claim 3, Applicant attributes delamination to the stresses imparted by the loss of organic functionality from the silicone component under the conditions recited by the claim. It is said however that this occurrence is precluded by the presence of an additive that soften and flows under these same conditions. Insofar as the composition taught by the reference contains an analogous material, the composition would inherently avoid delamination.

Given that the glass powder has a chemical constitution similar to those contemplated in Applicant's Specification, it inherently possesses a specific gravity of less than 2 (specific gravity is the same as density for solids). "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In the primary embodiment disclosed in the right-hand column of page 3, all of the materials mentioned in the abstract are mixed together prior to blending them in the melt. The resulting compositions are used as powder coatings on different substrates and, in one embodiment, a film derived therefrom has a thickness of 250 microns (page 3, left-hand column).

### ***Response to Arguments***

It is Applicants' position that, not only is the glass component of the prior art not crystalline, but also the particles do not take the form of spheroids.

The Examiner finds it curious that Applicant would insist that the glass particles taught by Yokota must be amorphous given that it is, in the common sense, an amorphous material as identified by a Wikipedia entry insofar as one embodiment of their high temperature matrix material is *inorganic glass*. Further, it is not insignificant that the invention taught by Yokota is employed in precisely the same capacity, i.e. as a powder coating, because the skilled artisan would, as a matter of routine

experimentation, investigate different glass types to identify that which imparts the most beneficial properties. The Examiner invited Applicant to produce experimental data that unequivocally illustrated the superiority of crystalline glass but they have not yet furnished any empirical results that might compel the withdrawal of the invention. As to the notion that the glass particles taught by the prior art are not spheroids, the Examiner respectfully disagrees. "Spheroid", as defined by Applicant, means generally spherical in shape. To reiterate, the reference describes the size of their particles in terms of a single measurement which would indicate that they are roughly spherical. Moreover, there is nothing in the record that illustrates that Applicants' glass component contains any fewer imperfections, e.g. jagged edges, than does that of the prior art.

Finally, while it is acknowledged that Applicants' invention is perhaps devoid of alumina, Applicants' disclosure does not serve to particularly exclude this material either.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 24, 2009

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796